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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/371,769	08/10/1999	ERWIN HACKER	514413-3765	9638
20999 7590 08/18/2010 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER				
PRYOR, ALTON NATHANIEL				
ART UNIT		PAPER NUMBER		
1616				
MAIL DATE		DELIVERY MODE		
08/18/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/371,769

Applicant(s)

HACKER ET AL.

Examiner

ALTON N. PRYOR

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 14, 23, 47, 52, 58, 74 and 78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 14, 23, 47, 52, 58, 74 and 78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE-C/3)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's arguments, see paper, filed 7/12/10, with respect to the rejection(s) of claim(s) under 35 USC 103(a) mailed 1/13/10 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below. Previous rejections/issues not discussed below have been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13,14,23,47,52,58,74 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruegg et al (US 6180563; 1/30/01).

Ruegg teaches a method for controlling weeds in crops including cotton comprising applying to the crop a composition comprising trifloxysulfuron plus at least one compound including glyphosate, glufosinate, pyriithobac, sethoxydim, and clethodim. See abstract, column 1 line 5 – column 6 line 35, column 11 line 32 – column 12 line 21. Ruegg does not teach or suggest an explicit method or composition for controlling weed in cotton comprising applying to cotton a composition comprising glufosinate and pyriithobac or clethodim. However, it would have been obvious to one having ordinary skill in the art to make instant invention comprising trifloxysulfuron plus glufosinate plus pyriithobac or clethodim. One would have been motivated to do this

because Ruegg suggests the combination of ingredients and the herbicidal effectiveness of the combination would have been broaden as a result of the combination. Applicant provides unexpected results for the combination of 105 g a.s./ha pyriithobac plus 400 g a.s./ha glufosinate as shown on pages 31-35 of the specification. Thus, the invention comprising the combination of 400 g a.s./ha glufosinate plus 105 g a.s./ha pyriithobac is allowable. No other combination of glufosinate and pyriithobac is allowable since Applicants provide only this single result for the combination of glufosinate and pyriithobac. Applicants provide no unexpected (synergistic) data for the combination of glufosinate and clethodim. Thus, no combination of glufosinate and clethodim is allowable.

Claim Rejections - 35 USC § 112

Claims 13,14,23,47,52,58,74 and 78 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of using synergistic combination of 400 g a.s./ha glufosinate plus 105 g a.s./ha pyriithobac as shown on pages 31-35 of the specification, does not reasonably provide enablement for all other claimed combinations of glufosinate plus pyriithobac. In addition, no unexpected (synergistic) data for the combination of glufosinate and clethodim are provided. Thus, no combination of glufosinate and clethodim is enabled.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Attention is directed to In re Wands, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing Ex parte Forman, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence or absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art,
- 7) the predictability of the art, and
- 8) the breadth of the claims.

The instant specification fails to provide guidance that would allow the skilled artisan to practice the instant invention without resorting to undue experimentation, as discussed in the subsections set forth infra.

The nature of the invention. The invention discloses a method for controlling weeds in cotton comprising applying to the crop a synergistic composition comprising glufosinate and pyrithiobac or clethodim..

The State of the Prior Art. Ruegg teaches a method for controlling weeds in crops including cotton comprising applying to the crop a composition comprising trifloxysulfuron plus at least one compound including glyphosate, glufosinate, pyrithiobac, sethoxydim, and clethodim. See abstract, column 1 line 5 – column 6 line 35, column 11 line 32 – column 12 line 21. Ruegg does not teach or suggest an explicit method or composition for controlling weed in cotton comprising applying to cotton a composition comprising glufosinate and pyrithiobac or clethodim. However, it would

have been obvious to one having ordinary skill in the art to make instant invention comprising trifloxysulfuron plus glufosinate plus pyriithiobac or clethodim. One would have been motivated to do this because Ruegg suggests the combination of ingredients and the herbicidal effectiveness of the combination would have been broaden as a result of the combination.

The Amount of Direction or Guidance Present. The disclosure provides unexpected results for the combination of 105 g a.s./ha pyriithiobac plus 400 g a.s./ha glufosinate as shown on pages 31-35 of the specification. Thus, the invention comprising the combination of 400 g a.s./ha glufosinate plus 105 g a.s./ha pyriithiobac is allowable.

The Presence or Absence of Working Examples. The examples present in the specification are a representation of the combination of 105 g a.s./ha pyriithiobac plus 400 g a.s./ha glufosinate in claim on the control of weeds in plants (see pages 31-35 of the specification).

The Quantity of Experimentation Needed. The applicant needs to provide significantly more synergistic data (covering a broad range of amounts) for the combination of glufosinate and pyriithiobac in order to avoid the inclusion of amounts from Table at pages 31-35 in the claims. In order for Applicant to make claim to an invention comprising a synergistic combination of glufosinate plus clethodim, Applicant must provide data showing that the combination is synergistic. Applicants provide no unexpected (synergistic) data for the combination of glufosinate and clethodim. Thus, no combination of glufosinate and clethodim is allowable.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/
Primary Examiner, Art Unit 1616